

REMARKS

Claims 1 to 12 are pending in the present application. In an Office Action mailed November 4, 2002, the Examiner allowed claims 8 to 10. Applicant thanks the Examiner for his careful consideration of these claims. The Examiner also objected to claims 3 to 6 and rejected Claims 1, 2, 7, 11 and 12. In view of the following remarks, Applicant respectfully requests reconsideration of Claims 1 to 8, 11 and 12.

The Examiner states that Claims 3 to 6 are objected to as dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. Again, Applicant thanks the Examiner for his careful consideration of these claims. However, Applicant has elected to traverse each requirement not complied with in the base and intervening claims.

The Examiner rejected Claims 1, 2, 7 and 12 under 35 U.S.C. § 102 as anticipated by U.S. Pat. No. 4,987,448 by Chikama. Applicant respectfully traverses this rejection.

The Examiner submits that Applicant's invention is anticipated by Chikama. The Examiner states that "Chikama teaches a register cam (Fig. 2) for use in a printing press comprising a body (15) and at least two cam arms (11B and 11C) extending outward from the body." Applicant respectfully disagrees. Chikama teaches a skewing detection mechanism (10) for detecting transport malfunctions of a continuous recording form. The apparatus cited by the Examiner as a register cam in Fig. 2 are not a registration cam as disclosed and claimed by Applicant but are instead components of skewing detection mechanism (10). Particularly, sensing arm (11B) and push arm (11C) taught by Chikama do not function as cam arms as disclosed and claimed by Applicant. Sensing arm (11B) merely follows the continuous feed of paper as it is fed through the printer and push arm (11C) merely supports a push bar (12) against gravity until the sensing arm (11B) loses contact with the paper and the push bar (12) is released from push arm (11C). Thus, sensing arm (11B) and push arm (11C) function as a lever and support, respectively, not as cam arms as suggested by

the Examiner. Therefore, a rejection of Claims 1, 2, 7 and 12 as anticipated by Chikama is inappropriate.

Accordingly, Applicants respectfully request that the rejection of Claims 1, 2, 7 and 12 under 35 U.S.C. § 102(b) be withdrawn.

The Examiner rejected Claim 11 under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 4,959,910 by Hamilton. Applicants respectfully traverse this rejection.

The Examiner contends that "Hamilton teaches a register cam (Fig. 2A) for a printing press comprising at least a first face (front side of 14) and a second face (back side of 14) with said first face having a first profile and the second face having a second profile." The Examiner further contends that this structure presented by Hamilton is sufficient to reject Applicant's Claim 11 "since the language concerning the faces being 'selectable' does not set forth any structure and is hence not sufficient to patentably distinguish the claimed invention from the prior art." Applicant respectfully disagrees.

The Federal Circuit has expressly mandated that functional claim language be considered in evaluating a claim relative to the prior art. Lewmar Marine, Inc. v. Varient, Inc., 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987) ("so that" functional clause of claim renders reference non-anticipating); Raytheon Co. v. Roper Corp., 220 U.S.P.Q. 592 (Fed. Cir. 1983) (to the patentee's disadvantage, since it rendered the claimed combination inoperative under 35 U.S.C. § 101). The M.P.E.P. supports this position at § 2173.05(g) stating, *inter alia*:

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it *fairly conveys* to a person of ordinary skill in the pertinent art *in the context in which it is used*. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular *capability* or purpose that is served by the recited element, ingredient or step. (emphasis added)

Applicant respectfully submits that the "selectable" limitation "fairly conveys" the novel "capabilities" of Applicant's invention to a person of ordinary skill in the art as used in the claim and as set forth in the specification and figures.

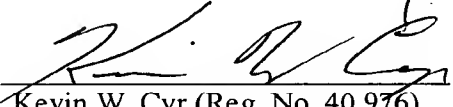
Accordingly, Applicants respectfully request that the rejection of Claim 11 under 35 U.S.C. § 102(b) be withdrawn.

In view of Applicant's amendments and remarks, the claims are believed to be in condition for allowance. Reconsideration, withdrawal of the rejections, and passage of the case to issue is respectfully requested. If any fees not accounted for above are due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 02-3732.

Respectfully submitted,

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By


Kevin W. Cyr (Reg. No. 40,976)
Attorney for Applicant
BRIGGS & MORGAN, P.A.
2400 IDS Center
80 South Eighth Street
Minneapolis, MN 55402
(612) 334-8522